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09/940,970	08/28/2001	Paul Trpkovski	44046.103.203.21	6340

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INTELLECTUAL PROPERTY GROUP
FREDRIKSON & BYRON, P.A.
4000 PILLSBURY CENTER
200 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402

EXAMINER

A, PHI DIEU TRAN

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,970

Applicant(s)

TRPKOVSKI, PAUL

Examiner

Phi D A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-9 and 11-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-9 and 11-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/29/03 has been entered.

Claim Objections

2. Claim 12 is objected to because of the following informalities: claim 12 depended upon canceled claim 10. Should it be depended upon claim 9 instead? Appropriate correction is required.

The claim is examined as best understood as depended upon claim 9.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Merritt (6458440) and Bigler (1284997).

Adams Jr. et al (figure 4B) shows a method comprising providing masking material and an adhesive disposed over a first face of the substrate (col 3 lines 53-55), providing a pane (18)

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having a surface, an unmasked apron of the surface of the pane surrounding the protective covering, the unmasked apron being large enough to receive a sash (28) yet small enough that the protective covering protects a portion of the pane not covered by the sash.

Adams et al does not show the step of calculating a number of strips and an overlap dimension for forming a protective covering sized so that an unmasked apron of the surface of the pane will surround the protective covering, forming the covering by applying masking material strips onto the surface of the pane in a sequentially overlapping fashion with each subsequent strip partially overlapping a preceding strip by the overlap dimension, forming a tab by folding the substrate of at least one strip so that a first portion of the substrate overlaps a second portion of the substrate.

Merritt shows a step of forming a protective covering on a glass pane with tabs to enable easy removal of the covering from the glass pane.

Bigler shows the step of covering a large area with sequentially overlapping layers of protective coverings.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al to show the step of calculating a number of strips and an overlap dimension for forming a protective covering sized so that an unmasked apron of the surface of the pane will surround the protective covering, forming the covering by applying masking material strips onto the surface of the pane in a sequentially overlapping fashion with each subsequent strip partially overlapping a preceding strip by the overlap dimension, forming a tab by folding the substrate of at least one strip so that a first portion of the substrate overlaps a second portion of the substrate because predetermining the required quantity of a covering

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needed to cover an area by its dimensions and overlapping dimensions is well known in the art as it would enable a person to predetermine the quantity of covering required and thus have the necessary supply available for use and thus save time, and having the covering sequentially overlapping each other would enable the covering of a large area without resorting to a large piece of covering material as taught by Bigler, and having a tab formed by folding the substrate so that at least a portion of the substrate overlapping a second portion of the substrate would enable easy removal of the covering from the glass pane, and the examiner takes Official Notice of the equivalence of a folded tab and an unadhesived tab for their use in the covering art and the selection of any of these known equivalents to enable easy peeling of the covering would be within the level of ordinary skill in the art.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Bigler (1284997) and Smith (5330232).

Adams Jr. et al (figure 4B) shows a method of covering the window assembly having an insulating glass unit by providing masking material comprising a substrate and an adhesive disposed over a first face of the substrate, a pane (18) having a pane surface, forming an unmasked apron on the pane around the covering, the apron being large enough to receive a sash yet small enough that the covering protects a portion of the pane not covered by the sash.

Adams Jr. et al does not show the step of calculating a number of strips and an overlap dimension for forming a protective covering sized so that an unmasked apron of the pane surface surrounds the protective covering, applying a plurality of masking material strips onto the pane surface in a sequentially overlapping fashion according to the overlap dimension, applying an information bearing sheet over the covering.

Smith (figure 6-7) shows the method step of applying an information bearing sheet over a substrate.

Bigler shows the steps of overlapping covering strips to cover a large area.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al to show the step of calculating a number of strips and an overlap dimension for forming a protective covering sized so that an unmasked apron of the pane surface surrounds the protective covering, applying a plurality of masking material strips onto the pane surface in a sequentially overlapping fashion according to the overlap dimension because predetermining the required quantity of a covering needed to cover an area by its dimensions and overlapping dimensions is well known in the art as it would enable a person to predetermine the quantity of covering strips required and thus have the necessary supply available for use and thus save time, and having the covering sequentially overlapping each other would enable the covering of a large area without resorting to a large piece of covering material as taught by Bigler, and having an information bearing sheet on the covering as taught by Smith would enable the covering to illustrate designs, advertisement, and instructions for users/workers/onlookers.

4. Claims 5, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Bigler (1284997) and Smith (5330232).

Adams Jr. et al as modified shows all the claimed limitations except for the information bearing sheet comprising a sheet stock and a second adhesive disposed upon a first face of the sheetstock, a second adhesive disposed upon a first face of the sheetstock, the sheetstock comprising a substantially frangible material, the sheetstock being paper.

Smith further shows the bearing sheet being a sheetstock and a second adhesive(43) disposed on a first face of the sheetstock (figure 7), the sheet stock being a substantially frangible material, the sheet stock being paper.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al's modified structure to show the information bearing sheet comprising a sheet stock and a second adhesive disposed upon a first face of the sheetstock, a second adhesive disposed upon a first face of the sheetstock, the sheetstock comprising a substantially frangible material, the sheetstock being paper as taught by Smith because it would enable the easy application of information on a substrate as taught by Smith.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Bigler (1284997) and Smith (5330232).

Adams Jr. et al as modified shows all the claimed limitations except for the second adhesive having substantially greater adhesion than the first adhesive.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams et al's modified structures to show the second adhesive having substantially greater adhesion than the first adhesive because it would enable easy peeling away of the information material from the covering without removing the covering from the pane surface.

6. Claims 9, 12, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Bigler (1284997).

Adams Jr. et al (figure 4B) shows a window assembly having an insulating glass unit (18, figure 4B) including a first pane having a first surface, a protective covering (22b, 24b) disposed

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over a masked portion of the first surface of the first pane, the protective covering being sized and positioned so that an unmasked apron of the surface extends between an outer periphery of the protective covering and an outer periphery of the pane, the unmasked apron (20b) being large to receive a sash (26, figure 5B) yet small enough that the protective covering protects a portion of the pane not covered by the sash.

Adams Jr. et al does not show the protective covering comprising a plurality of strips disposed across the first surface of the first pane in a sequentially overlapping fashion with each subsequent strip overlapping a portion of a preceding strip by an overlap dimension, so that the protective covering can be easily removed on strip at a time.

Bigler shows a plurality of covering strips overlapping sequentially to provide covering to a large surface, the first strip being overlapped a portion by an overlap dimension by a subsequent strip.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams et al to show the protective covering comprising a plurality of strips disposed across the first surface of the first pane in a sequentially overlapping fashion with each subsequent strip overlapping a portion of a preceding strip by an overlap dimension, so that the protective covering can be easily removed on strip at a time because it was known in the art that covering a large surface with multiple covering strips of material instead of a large one would enable cost savings per manufacturing and transportation ease as taught by Bigler.

Per claims 12, 24, Adams et al as modified by Bigler shows the plurality of strips comprising a second strip partially overlapping a first strip, a third strip partially overlapping the second strip, the plurality of trips comprising n strips with the nth strip partially overlapping an

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(n-1) strip of the plurality of protective strips, each strip of the protective covering having a tab portion (the part overlapping each other).

7. Claims 11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Bigler (1284997) and further in view of Merritt (6458440).

Adams Jr. et al as modified shows all the claimed limitations except for the first strip comprises a first tab, the nth strip comprises an nth tab.

Merritt discloses a plurality of coverings each having a tab to enable easy removal of the coverings from the protected glass surface.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al's modified structures to show the first strip comprises a first tab, the nth strip comprises an nth tab because having a tab at the end each covering would enable easy removal of the covering from a glass pane as taught by Merritt.

8. Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Bigler (1284997) as applied to claim 9 above and further in view of Smith (5330232)

Adams et al as modified by Bigler shows all the claimed limitations except for an information bearing sheet overlaying the protective covering, the information bearing sheet comprising a sheetstock having a first side and a second side, the information bearing sheet including second indicia printed on a second side thereof, the information bearing sheet including first indicia printed on a first side thereof, the information bearing sheet including a second adhesive overlaying the first indicia and the first side of the sheetstock.

Smith (figure 7) shows an information bearing sheet (44) overlaying the protective covering(24), the information bearing sheet comprising a sheetstock having a first side and a second side, the information bearing sheet including second indicia (25) printed on a second side thereof, the information bearing sheet including first indicia (46) printed on a first side thereof, the information bearing sheet including a second adhesive(43) overlaying the first indicia and the first side of the sheetstock

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams et al's modified structure to show an information bearing sheet overlaying the protective covering, the information bearing sheet comprising a sheetstock having a first side and a second side, the information bearing sheet including second indicia printed on a second side thereof, the information bearing sheet including first indicia printed on a first side thereof, the information bearing sheet including a second adhesive overlaying the first indicia and the first side of the sheetstock as taught by Smith because having the information bearing sheet having indicia on either first or second side with a second adhesive overlaying the indicia on the first side of the sheetstock would enable the easy application of the information bearing sheet to the substrate as taught by Smith.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Smith (5330232) and Bigler (1284997).

Adams Jr. et al as modified shows all the claimed limitations except for the second adhesive having substantially greater adhesion than the first adhesive.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams et al's modified structures to show the second adhesive having

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substantially greater adhesion than the first adhesive because it would enable easy peeling away of the information material from the covering without removing the covering from the pane surface.

10. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Smith (5330232) and Bigler.

Adams Jr. et al as modified shows all the claimed limitations except for the second adhesive and the protective covering being substantially transparent or substantially translucent.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams et al's modified structures to show the second adhesive and the protective covering being substantially transparent or substantially translucent because having translucent/transparent covering and adhesive would enable the seeing through of the covered glass pane and thus allowing sun-light into a working environment which results in an appealing/lighted work area.

11. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Smith (5330232) and Bigler.

Adams et al as modified shows all the claimed limitations except for the indicia having an advertisement for goods likely to be purchased, the indicia having a National Fenestration Rating Council rating for the window assembly.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Smith to show the indicia having an advertisement for goods likely to be purchased, the indicia having a National Fenestration Rating Council rating for the window assembly because it would have been an obvious matter of design choice to show the indicia

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having an advertisement for goods likely to be purchased, or the indicia having a National Fenestration Rating Council rating for the window assembly as the establishment of different advertisements and instructions on a label is well-known in the art.

12. Claims 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Bigler.

Adams et al as modified shows all the claimed limitations except for an adhesive disposed over a first face of the substrate, the tab portion of each strip overlapping a second portion of the substrate so that the adhesive overlaying the first portion is adhered to the adhesive overlaying the second portion.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al's modified structure to show an adhesive disposed over a first face of the substrate, the tab portion of each strip overlapping a second portion of the substrate so that the adhesive overlaying the first portion is adhered to the adhesive overlaying the second portion because it would further enhance the attachment of one strip of the protective covering to another strip of the protective covering.

13. Claims 26-28, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Bigler.

Adams Jr. et al shows a method of protecting a masked area of a surface having the steps of providing masking material having a width, the protective covering having a plurality of strips, the covering having an unmasked apron on the first surface surrounding the protective covering.

Adams Jr. et al does not show the step of providing the width of the masking material to a masking calculator, providing a desired width of the masking area to the masking calculator, calculating a number of strips and an overlap dimension for forming the covering sized so that an unmasked apron of the first surface surrounds the covering, applying the plurality of strips to the surface in an overlapping fashion according to the overlap dimension, the step of detecting a dimension of the planar surface.

Bigler shows the steps of covering a large area with a protective covering by overlapping a plurality of covering in sequential fashion with each strip partially overlapping a preceding strip by the overlap dimension.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al to show the step of providing the width of the masking material to a masking calculator, providing a desired width of the masking area to the masking calculator, calculating a number of strips and an overlap dimension for forming the covering sized so that an unmasked apron of the first surface surrounds the covering, applying the plurality of strips to the surface in an overlapping fashion according to the overlap dimension as taught by Bigler, the step of detecting a dimension of the planar surface because having the protective covering made of a plurality of strips to cover a large area instead of a large one would enable cost savings per manufacturing and transportation ease, and the use of a calculator, a computer etc...to calculate an optimum result per a certain dimension of a covering is well-known in the art as it helps provide quick accurate calculations and thus cost savings.

14. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Smith (5330232).

Adams Jr. et al (figure 4B) shows a method of covering the window assembly having an insulating glass unit by providing masking material comprising a substrate and an adhesive disposed over a first face of the substrate, a pane (18) having a pane surface, forming a protective covering comprising the masking material on a surface of a pane, the protective covering being sized and positioned so that an unmasked apron of the surface extends between an outer periphery of the protective covering and an outer periphery of the pane, the unmasked apron (20b) being large to receive a sash (26, figure 5B) yet small enough that the protective covering protects a portion of the pane not covered by the sash, the covering and the glass pane being transported to a point of use.

Adams Jr. et al does not show the step of providing information related to the window assembly, printing the information on a sheet and attaching the information bearing sheet to the protective covering, transporting the information bearing sheet to a point of use.

Smith (figure 6-7) shows the method step of applying an information bearing sheet over a substrate.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al to show the step of providing information related to the window assembly, printing the information on a sheet and attaching the information bearing sheet to the protective covering as taught by Smith, transporting the information bearing sheet to a point of use because having information bearing sheet on the covering would enable the covering to illustrate designs, advertisement, instructions for users/workers/onlookers, and having the information bearing sheet on the covering during transportation would enable a worker transporting the window pane to have access to required handling equipment and is thus desired.

Response to Arguments

15. Applicant's arguments with respect to claims 1,4-9, 11-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different covering designs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phi Dieu Tran A

3/20/04